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April 30, 2004
Paper No. 12
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Belanoff

Serial No. 78022004

Jeffrey R. Belanoff, pro se.

John M. Gartner, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Simms, Seeherman and Hohein, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Jeffrey R. Belanoff, a citizen of the United States, has filed an application to register the term "SUPERSURVEYS" as a service mark for "conducting public opinion polls and surveys for non-business, non-marketing purposes."¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's services, the term "SUPERSURVEYS" is merely descriptive thereof.

¹ Ser. No. 78022004, filed on August 20, 2000, which is based on an allegation of a bona fide intention to use such term in commerce.

Applicant has appealed. Briefs have been filed,² but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or

² The Examining Attorney, noting that the "TABLE OF CITED AUTHORITIES" in applicant's brief sets forth a list which includes various third-party registrations which were not made of record by applicant's having previously submitted copies thereof, has properly objected in his brief to consideration of such evidence on the ground that it is untimely under Trademark Rule 2.142(d). In addition, the Examining Attorney, citing In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974), correctly notes that inasmuch as the Board does not take judicial notice of third-party registrations, a mere list of such does not suffice to make the registrations of record; rather, copies of the registrations or printouts thereof from the electronic search records of the United States Patent and Trademark Office must be timely furnished. While no consideration will be given to evidence which has not been properly made of record, it is nonetheless pointed out that, even if such evidence were to be considered, it would make no difference in the disposition of the issue of mere descriptiveness.

services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant, in his response to the initial Office Action, conceded with respect to the term "SUPERSURVEYS" that, "[w]hen broken down to its components, 'super' and 'surveys,' and taken by the summation of their literal definitions, this mark does seem merely descriptive" of his services. Applicant added that "[i]t is not my intention, however, to define or advertise my surveys as a superlative or laudatory phrase" and that, while "I hope my products will be thought of in the superlative, ... this is not what I mean by the name." Instead, as argued in his brief, applicant contends that the term "SUPERSURVEYS" "is not merely descriptive of his services because, *inter alia*, such term "is submitted intentionally as a unitary mark, not intended to be considered in its component form," which combines the words "SUPER" and "SURVEYS" in a manner that their "juxtaposition ... is inventive or evokes a unique commercial impression"; that, in light of the multiplicity of meanings for the words comprising the term "SUPERSURVEYS," it is the case that "[m]ultiple impressions and entendres can be demonstrated depending on context and the individual's point of view"; that, as shown by various third-party registrations, marks which are comprised of

the formative term "SUPER" and another word "constitute some evidence of record or reasonable precedent" that the term "SUPERSURVEYS" should likewise be regarded as registrable; and that, in particular, the "alliterative nature" of such term "lend[s] a unique, distinct and memorable quality to the term."

The Examining Attorney, citing the definitions of record from The American Heritage Dictionary of the English Language (3rd ed. 1996) of the prefix "SUPER-" as signifying "[s]uperior in size, quality, number or degree" and the word "SURVEY" as meaning "[t]o conduct a statistical survey on," contends in his brief that:

The examining attorney disputes applicant's claim that the examining attorney failed to view applicant's mark as a whole in finding that the mark was merely descriptive of the services. In this case, SURVEYS is clearly the generic name for applicant's survey services, and applicant has not disputed this. The word SUPER, as used by applicant, can only be reasonably viewed as conveying the meaning ... [of] a prefix meaning "superior in size, quality, number, or degree." As such, the term is used in a laudatory manner. Laudatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under §2(e)(1). [citations omitted.] Having concluded that SUPER is a laudatory term and that SURVEYS is the generic term for the services, the Examining Attorney combined the terms as SUPERSURVEYS to judge the mark as a whole. It was only then, viewing the mark as the entire mark SUPERSURVEYS, that the examining attorney concluded that the mark merely describes the services. This conclusion was based on the fact that SUPERSURVEYS, as a combined mark, does not convey a commercial impression that is separate from the descriptive impression created by the individual words SUPER and SURVEYS.

We agree with the Examining Attorney that the term "SUPERSURVEYS" is merely descriptive of applicant's services. Such term immediately describes, without any conjecture or speculation, the conducting of public opinion polls and surveys for non-business, non-marketing purposes which are superior in quality or degree. Nothing in the term "SUPERSURVEYS," when used in connection with applicant's services, requires the exercise of imagination, cogitation or mental processing or necessitates the gathering of further information in order for the merely descriptive significance thereof to be readily apparent. Plainly, the individual terms comprising the term "SUPERSURVEYS" have a meaning when combined which ordinary usage would ascribe to those terms in combination, and the fact that applicant insists that "it is a new compound word" which presumably does not appear in any dictionary is simply not controlling on the question of registrability. See In re Gould Paper Corp., 824 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) and In re Orleans Wines, Ltd., 196 USPQ 516, 517 (TTAB 1977).

Admittedly, it is possible, as applicant argues and the Examining Attorney acknowledges, for individually descriptive words to be combined to form a valid, registrable mark which, as a whole, is not merely descriptive. Specifically, as set forth, for instance, in TMEP Section 1209.03(d) (3d ed. 2d rev. May 2003):

When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component

retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); ... *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts); ... *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE held to be merely descriptive of banking and trust services); *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (STEELGLAS BELTED RADIAL held merely descriptive of vehicle tires containing steel and glass belts); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of coasters suitable for direct mailing).

However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods [or services]. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products)
....

While we note, in the present case, applicant's assertions concerning the differences in connotation between such examples as "super man" and "Superman," "super bowl" and "Superbowl," and "super market" and "supermarket," the Examining Attorney counters by insisting that "Superman" and "Superbowl" are terms which, in addition to having "nothing whatsoever to do

with applicant's mark or applicant's services," "developed meanings over time that are distinct from the terms 'super man' and 'super bowl'" and that the word "supermarket," being "a generic term ..., hinders rather than helps applicant's argument." Suffice it to say that, as indicated above, we cannot discern any difference in commercial impression between "SUPER SURVEYS" as two separate words and their combination into the term "SUPERSURVEYS." In the latter case, no new and unique commercial impression is created inasmuch as nothing in the combination results in a unitary mark with a unique, nondescriptive meaning, nor does the composite have a bizarre or incongruous meaning as applied to applicant's services. Rather, the constituent elements retain their descriptive significance and the combination is itself merely descriptive of applicant's services.

Nonetheless, citing such sources as "The American Heritage Dictionary, Cassell's Concise English Dictionary and Dictionary.com," applicant maintains that (footnotes omitted):

Super is also defined as, "a superintendent in an apartment or office building" or "an extra or superfluous person, a supernumerary (theatrical performer without a speaking part)" or "superfine cloth or manufacturer" or, as a prefix, "placement above, over or outside". Survey is also defined as, "to determine the form, extent, position, etc. of" or "to ascertain the condition, value, etc. of" or "a department carrying this out" or "a general view".

Applicant argues that "[t]hese additional definitions and their possible combinations suggest many possibilities and unique interpretations of what 'supersurveys' might mean," such as

surveys about or conducted by either school superintendents or building superintendents, "a survey of chorus, cast members or understudies regarding their performances or the performances of featured players" or "a public opinion poll regarding particular clothing or fabrics."

We concur with the Examining Attorney, however, that when encountered in the context of applicant's services of conducting public opinion polls and surveys for non-business, non-marketing purposes," there simply is "no evidence in the record to suggest that applicant's polls or surveys have anything whatsoever to do with superintendents, and there is no evidence to suggest that applicant's customers would view ... SUPERSURVEYS as referring to superintendents or anything other than surveys that are 'super'" in the ordinary sense that they are superior in quality or degree. The term "SUPERSURVEYS" is thus merely descriptive of applicant's services in that it forthwith conveys, in a laudatory manner, that it is the services which are superior rather than designating the subject matter or topic of the surveys or polls being conducted, such as school or building superintendents, theatrical extras or even superfine cloth or manufacturers.

As to applicant's reliance on various third-party registrations, which he properly made of record, of marks which contain the word "SUPER" or another laudatory term,³ the

³ Such registrations are for the following marks and associated goods or services: "BEST FRIEND" for "restaurant, inn, hotel and motel services"; "BEST CARE" for "catalog mail order services in the field of pet health care"; "SUPERSUIT" (issued pursuant to Section 2(f) of

Examining Attorney, citing *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977), correctly notes that each case must be decided on its own merits and that "[a] mark which is merely descriptive is not registrable merely because other similar marks appear on the register." See, e.g., *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court"]; *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991). In any event, to the extent that they may be considered probative, none of the third-party registrations of record is persuasive of a contrary finding in this case, nor do

the Trademark Act, 15 U.S.C. §1052(f)) for "clothing--namely, weight-lifting suits and power lifting suits"; "SUPERSAVER" for "paint brushes and paint rollers"; "SUPERSET" for "modified and unmodified food starches for industrial use"; "SUPERSPIN" for computer programs for freight carrier management and forecasting"; "SUPERSTREAK" for "shuttle units for use with automated manufacturing machines for conveying components during different stages of manufacture and, in particular, for use in automotive manufacturing facilities"; "SUPER CYCLE" ("CYCLE" disclaimed) for "a controller ... for use with industrial air conditioning units having a cooling tower and a refrigerating unit"; "SUPER SMILE" for "toothpaste"; "SUPER SMOKE" ("SMOKE" disclaimed) for "cheese"; "SUPER SHIELD" for "ophthalmic lenses"; "SUPER SHIPPER" for "molded plastic industrial drums"; "SUPER STONE" for, *inter alia*, "bricks for baking and warming foods such as pizzas" and "covered stoneware baking dishes"; "SUPER SIPPER" for "laboratory equipment--namely, apparatus for introducing a liquid test sample into an analytical instrument"; and "SUPER SEAL" (issued on the Supplemental Register with "SEAL" disclaimed) for "vehicle rust preventative and undercoating sealer." It is pointed out, however, that the probative value of several of such registrations is limited inasmuch as the copies thereof which applicant submitted from Office records provide only partial information and thus, for example, do not indicate whether a term in the subject mark has been disclaimed or whether the registration issued either on the Principal Register, pursuant to a claim of acquired distinctiveness under Section 2(f) of the statute, or on the Supplemental Register.

they singly or collectively serve to create any doubt as to the mere descriptiveness of the term "SUPERSURVEYS" when used in connection with applicant's intended services. At most, what such registrations tend to show is that, when a laudatory term is coupled with an apparently suggestive word, the resulting mark is considered to be suggestive (e.g., "SUPERSAVER" for "paint brushes and paint rollers" or "SUPER SMILE" for "toothpaste"), but when such a term is combined with a word which clearly is descriptive or generic, the composite mark is regarded as merely descriptive (e.g., "SUPER SEAL" for "vehicle rust preventative and undercoating sealer" or "SUPERSUIT" for "clothing--namely, weight-lifting suits and power lifting suits"). Thus, like those composite marks in the latter category, the term "SUPERSURVEYS" combines the laudatory word "SUPER" with the descriptive, if not generic, term "SURVEYS" in such a manner that, for the reasons explained previously, the combination is merely descriptive of applicant's services.

Applicant, however, insists as a final consideration that the term "SUPERSURVEYS" creates a separate, non-descriptive commercial impression because it has "a neat, concise and classic alliteration with not only a triple repeating consonant 's' sound but also an embedded duplicative 'su' sound." Such alliterative sounds, applicant urges, "create a pleasing pattern which lend a unique, distinct and memorable quality to the term."

The Examining Attorney, on the other hand, persuasively maintains that:

In this case, there is nothing about the alliteration or sound quality of applicant's

mark that creates a distinct commercial impression. Instead, the laudatory term SUPER happens to begin with the same two letters as the generic term SURVEYS. The examining attorney notes that the "U" sound in each [constituent] word is different, with SUPER having a long "U" sound and SURVEYS a short "U" sound, so the "alliteration" applies only to the "S" and not the "U." This alliteration, by itself, ... is simply not enough to create in the minds of applicant's consumers the impression that the words [comprising the term] SUPERSURVEYS form a distinct mark rather than a descriptive phrase. *Compare In re Lean Line, Inc.*, 229 USPQ 781, 782 (TTAB 1986) (LEAN LINE not considered unitary; "there is nothing in the record to suggest that the mere fact that both words which form the mark begin with the letter 'L' would cause purchasers to miss the merely descriptive significance of the term 'LEAN' or consider the entire mark to be a unitary expression.")

Accordingly, we conclude that when used in connection with applicant's services of "conducting public opinion polls and surveys for non-business, non-marketing purposes," the term "SUPERSURVEYS" in its entirety immediately conveys information that applicant's surveys are superior in quality or degree. Such term, therefore, is merely descriptive of applicant's services within the meaning of the statute. See, e.g., *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) ["SUPER BLEND" held merely descriptive of "motor oils" as designating "an allegedly superior blend of oils"]; *In re Consolidated Cigar Co.*, 35 USPQ2d 1290, 1293-94 (TTAB 1995) ["SUPER BUY" found laudatory and hence merely descriptive of "cigars, pipe tobacco, chewing tobacco and snuff" inasmuch as term "ascribes a quality of superior value to the goods," in that they "are an exceptionally high value for their price," and is

"an expression of pre-eminence, analogous to a grade designation"]; In re Carter-Wallace, Inc., 222 USPQ 729, 730 (TTAB 1984) ["SUPER GEL" held merely descriptive of a "lathering gel for shaving" because term "would be perceived as nothing more than the name of the goods modified by a laudatory adjective indicating the superior quality of applicant's shaving gel"]; and In re Samuel Moore & Co., 195 USPQ 237, 241 (TTAB 1977) ["SUPERHOSE!" found merely descriptive of "hydraulic hose made of synthetic resinous materials" inasmuch as term "would be understood as the name of the goods modified by a laudatory adjective which would be taken to mean that applicant's hose is of superior quality or strength"].

Decision: The refusal under Section 2(e)(1) is affirmed.